

REPLY TO OFFICE ACTION OF 5/6/2003

SERIAL NO: 09/336,424
DOCKET NO: 149-0112US**REMARKS**

This paper is intended to be a complete response to the above-identified Office Action mailed on May 6, 2003.

It is believed that no fee is required. If fees are required, however, the Assistant Commissioner is authorized to deduct the necessary charges from Deposit Account 501922/149-0112US.

Claims 1-52 were pending. Claims 1-52 were rejected. No claim is amended, cancelled or added in this paper.

Procedural matters

The Applicants note that in the Office Action mailed on May 6, 2003, all of the pending claims were rejected under section 102, in view of four (4) prior art references *individually*. The Applicants appreciate the Examiner's effort in conducting a thorough search of prior art and thoroughly examining the currently patent application. But "Prior art rejections should ordinarily be confined strictly to the *best* available art." MPEP 706.02, page 700-20. The Applicants respectfully request the Examiner to *identify* the best prior art reference. The fact that the Examiner cannot determine the "best available art" to establish a section 102 rejection indicates that none of the rejections is well established. The Applicants submit, as will be discussed in more detail below, that none of the section 102 rejections are proper.

In addition, the Applicants submit that the Examiner has still failed to follow 37 C.F.R. § 1.104(c) in several rejections such that Applicants are not sure what grounds upon which the Examiner is basing his rejections. The Applicants submit that citing the entire summary of a reference or several columns in a reference against a claim, without identifying all the claimed elements in the reference is not "designated as nearly as practicable" nor "clearly explained." The Applicants submit that the nomenclature used in the claims and in the references are not the same in many instances. In others, even though the same or similar words may be used, such as

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"definition", "state change", "command," or "depend", they convey very different meanings due to their different context.

Furthermore, "A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." MPEP 707.07, Improperly Expressed Rejections, page 700-98. The Applicants respectfully request the Examiner either substantiate rejections against each member of a group of claims or withdrawn the rejections against the group.

Substantive Matters

The Applicants would like to draw the Examiner's attention to the two methods claimed in independent claims 1 and 12. The method claimed in claim 1 is directed to receiving a message sent from a remote device. The message has *three parts*: a first part called "definition", a second part called "state change" and a third part called a "command." The first two parts – "definition" and "state change" – are related to a user environment. Method in claim 1 is also directed to processing the received message, the first part – a "definition", the second part – a "state change", and third part – a "command" in that sequence.

The method claimed of claim 12 is similar to the method of claim 1 in that claim 12 is directed to sending a message that includes the aforementioned three parts. In addition, claim 12 requires recognizing that dependence on a remote device exists: the dependence being a need for the remote device to perform some act, said act allowing said application software program to continue to operate.

Section 102 Rejections

The Examiner rejected claims 1 through 52 under 35 U.S.C. § 102(e) as being anticipated by Agranat Patent No. 5,973,696.

It appears that Agranat is directed to an embedded web server. In rejecting claim 1 in view of Agranat, the Examiner cited to Figures 11 and 12 in Agranat and text in column 16, lines 45-65 describing those two figures. It appears that the Examiner

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asserts the HTTP message 1201 in Figure 12 of Agranat is equivalent to the message of claim 1, wherein the Examiner equates Agranat's "form name" to the recited "definition" part; "default values" to the recited "state change" part; and "submit" to the recited "command" part. The Applicants do not find "form name" as disclosed in Figure 12. There is item 1203 called ewaFormServe in Figure 12. The Applicants do not find a "submit" command in Figure 12, although there is a ewaFormsSubmit - item 1211 in Figure 12. Assuming that the Examiner asserts the item 1201 in Figure 12 is equivalent to the message in claim 1; item 1203 as the "definition"; item 1205 as the "state change"; and item 1211 as the "command," those items do not satisfy the requirements of claim 1. These four items, as disclosed in Figure 12, are messages/communication between three different entities: the browser, the emWeb/server, and the application. Those messages have different transmitters and recipients. Also, items 1203, 1205 and 1211 are not parts within item 1201. Therefore, they cannot be parts of a single message as required by claim 1. Assuming *arguendo* that the four items shown in Figure 12 are equivalent to the "message", "definition", "state change" and "command" required by claim 1, (which equivalence the Applicants have shown above does not exist), those four different items are transmitted or received at different times, seemingly following the sequence required by claim 1. But transmitting/receiving alone is not "processing" as required in the claim 1. Claim 1 requires both "receiving" a message comprising three parts *and* "processing" the message's three parts. Therefore, Agranat does not disclose any of the elements in claim 1. Consequently, claim 1 is not anticipated or made obvious by Agranat.

As to claim 12, Agranat does not anticipate or make obvious claim 12 regarding the requirement of the message, as discussed above regarding claim 1. In addition, claim 12 requires a dependence: "said dependence being a need for said remote device to perform some act, said act allowing said application software program to continue to operate." The Examiner cited a "document note," for example, item 1107 in Figure 11, and text at column 9, lines 3-11.; column 13, line 14- column 14, line 31. The text cited by the Examiner appears to be explaining that the web server in Agranat is

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capable of compiling a markup language document into a data structure in a native application programming language. It is not clear to the Applicants how a compiler in a web server to translate a mark-up language to a native language is related to the dependency between a remote site and a local site as claimed in claim 12. Accordingly, Agranat does not anticipate or make obvious the subject matter of claim 12.

All other claims incorporate at least the same limitations as those recited in claims 1 or claim 12. Therefore, all pending claims 1-52 are allowable for at least the same reasons as are independent claims 1 and 12.

The Examiner cited the same text in Agranat, col. 14, lines 32-44, in rejecting claims 2-5. The Applicants respectfully disagree. It appears that the text at col. 14, lines 32-44 discloses that the EmWeb has a compiler that supports various input fields, which may be a command, such as "SUBMIT" etc. But nothing in the cited passage of Agranat discloses or suggests that those input fields could embody an "express command" as recited in claim 2. Nowhere does Agranat even mention that the "express command" is "a clicking a mouse button" as in claim 3 or "hitting an enter key" as in claim 4, or "selecting an option from a menu" as in claim 5. The above cited text does mention "SELECT" and "OPTION" as two of the input fields supported by the compiler, but they have nothing to do with a command or an action of "selecting an option." (col. 14, line 34.) For at least these reasons, claims 2-5 are not anticipated or made obvious by Agranat.

The Examiner rejected claims 1 through 52 as being anticipated by Blinn, U.S. Patent No. 5,897,622.

It appears that Blinn discloses an electronic shopping and merchandising system. It appears that the Examiner asserts that HTML template 200 as shown in Figure 6 of Blinn is equivalent to the "message" of claim 1, equating: item 302 in Figure 9, a name label, to the recited "definition"; item 110 and 112 in Figure 6 to the recited "state change"; and item 202 in Figure 6 to the recite "command". Item 302, asserted by the

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Examiner to be equivalent to the recited "definition," is not a part of the template which is asserted to be equivalent to the recited "message." Therefore, Blinn does not disclose the first element in claim 1. In addition, claim 1 requires a particular sequence of processing the different parts of the "message." For example, the "command" is processed last. The Examiner asserts that item 125 in Figure 10 as processing the "definition" and item 129 in Figure 10 as processing "state change." The Applicants respectfully disagree. Item 125, as shown in Figure 10, is a dynamic page generator and item 129 is an order processing module. Neither of those two modules define the processing sequence of the three parts of the "message." In fact according to the template on Figure 6, item 200, those items are usually processed or interpreted by web servers in sequence, so that in 202 (fetchrows product "get product") in Figure 6, supposedly a "command," is processed first. Accordingly, Blinn does not disclose or fairly suggest the recited elements of claim 1. Therefore, claim 1 cannot be anticipated or made obvious by Blinn.

As to claim 12, it is not anticipated or made obvious by Blinn for at least the same reasons as cited above with respect to claim 1. In addition, nothing in Blinn teaches the element regarding dependence. As discussed in responses to earlier Office Actions, web browsers and web servers generally operate independently. The Examiner cited column 3, line 1 through column 4, line 26 in Blinn as disclosing the dependence on a remote device. The cited text in Blinn is the summary of the invention of Blinn. The Examiner has not pointed out, as required by 37 CFR 1.104(c), what in Blinn, if there is anything, to be equivalent to the dependence as claimed in claim 12. The Applicants submit there is none. Therefore, claim 12 is allowable in view of Blinn.

All other claims incorporate at least the same limitations as those recited in claims 1 or 12. Therefore, all pending claims 1-52 are allowable for at least the same reasons as are independent claims 1 and 12.

The Examiner asserts that "regarding to dependent claims 2-11, 27-36, the limitations of these claims are taught within the figures and cited areas (Blinn, Fig. 12; items 123, 125, 126, 127, 129; col. 17, line 18 – col. 19 line 15)." Similarly, the

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Examiner asserts that claims 13-25, 38-50 are taught by Blinn within the same figures and cited areas. The Applicants submit that such rejections are improper because of improper grouping. The Applicants respectfully request the rejections be substantiated regarding each individual claim in the group or be withdrawn.

The Examiner rejected claims 1 through 52 as being anticipated by Levine U.S. Patent No. 5,745,681.

It appears that Levine discloses a stateless shopping cart for the web, a similar art as in Blinn. The Examiner asserts that a shopping page is equivalent to the recited "message" and that the server item 152 in Figure 2A is equivalent to the recited "remote device". The Examiner also asserts that the web page shown in Figure 4 contains the parts of the "message": item 56a - an icon of a disk as a "definition"; item 62 - a list of product as a "state change"; and item 64 - an add button as a "command". It is not clear to the Applicants how the shopping page in Figure 4 is equivalent to a "message" while the server is equivalent to a "remote device." In Levine, the message is processed by the server, but claim 1 recites that the message is *sent* from the remote device (server) and inherently processed by something else (i.e. a local device). As far as the web browser is concerned, after it receives the shopping page, the browser just displays the shopping page without further processing. A user may press the "add button" to cause an action at the web server, but that is an action unrelated to receiving the shopping page. Furthermore, there is no indication regarding the sequence of how the items 56a, 62 and 64 are "processed" or even whether there is any "processing." Therefore, Levine does not disclose the first element of claim 1. The Examiner cited a Figure 10, item 129 on page 12 of the Office Action in reference to the second element of claim 1. The Applicants cannot locate either Figure 10 or item 129 in Levine. Therefore, the Examiner failed to show Levine discloses the second element in claim 1. Therefore, claim 1 is not anticipated or made obvious by Levin.

As to claim 12, it is not anticipated or made obvious by Levine for the same reason as in claim 1. In addition, nothing in Levine teaches the element regarding

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dependence. The Examiner cited column 1, line 50 – col. 2, line 51 in Levine, which is the summary of the invention of Levine. The Examiner has not pointed out, as required by 37 CFR 1.104(c), what in Levine, if there is anything, to be equivalent to the dependence as claimed in claim 12. The Applicants see none. Therefore, claim 12 is allowable in view of Levine.

The Examiner asserts that "Regarding to dependent claims 2-11, 27-36, the limitations of these claims are taught within the figures and cited areas (Levine, Figs. 4-6, col. 5, line 1 – col. 6, line 67)." The Examiner similarly rejects claims 13-25, 38-50 in a group. The Applicants respectfully disagree. The Applicants submit that such rejections are improper because of improper grouping and because of failing to satisfy 37 C.F.R. § 1.104(c) requirement. The Applicants respectfully request the rejections be substantiated regarding each individual claim that has unique limitations or be withdrawn.

The Examiner rejected claims 1 through 52 as being anticipated by Saliba U.S. Patent No. 6,052,710.

The Examiner asserts that HTTP message are equivalent to the recited "message", item 108 (user computer) is equivalent to the recited "remote device," item 200 web Doc as equivalent to the recited "definition", function calls for price or inventory information as equivalent to the recited "state change", and item 204 user selectable button as equivalent to the recited "command." It appears that the Examiner managed to find the four objects in Saliba and asserted them to be the four objects cited in claim 1. The Applicants submit that these items cannot be equivalent. The HTTP message sent by item 108 (user computer) is not the same as the HTTP message sent by the server. The message containing item 200 web Doc and item 204 user selectable button is from a server not item 108, the users computer, as asserted by the Examiner. (Col. 8, lines 23 – 29.) It appears that Saliba discloses that a user may click on a button (item 204), send a function call to the server and that the server processes the function call (col. 8, lines 29-33). There is no disclosure or suggestion in Saliba that

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this function call is the same HTTP message as containing the three items asserted by the Examiner. Therefore, Saliba does not disclose the four objects in the first element of claim 1. Since Saliba does not disclose the four objects required in claim 1, Saliba cannot disclose the processing of the undisclosed objects. Therefore, Saliba does not disclose the second element in claim 1 either. Consequently, Saliba does anticipate or make obvious claim 1.

As to claim 12, it is not anticipated or made obvious by Saliba for at least the same reasons as cited above with respect to claim 1. In addition, nothing in Saliba teaches the "dependence" required in claim 12. The Examiner asserts that the text at col. 6, lines 50-63 of Saliba discloses the dependence. It appears that Saliba mentions "depend" in: "These specialized functions will *depend* upon the particular application for which the commerce client and server 132, 136 are being provided," (col. 6, lines 59-61). But the "dependence" here is dependence between the specialized functions available and the particular applications installed; the "dependence" disclosed in Saliba is not between remote device and a software on a local device as required in claim 12. Therefore, Saliba does not anticipate or make obvious claim 12.

The Examiner asserts that "Regarding to dependent claims 2-11, 27-36, the limitations of these claims are taught within the figures and cited areas (Saliba, Fig. 2, col. 7, line 60 – col. 9, line 26)." The Examiner similarly rejects claims 13-25, 38-50 in a group. The Applicants respectfully disagree. The Applicants submit that such rejections are improper because of improper grouping and because of failing to satisfy 37 C.F.R. § 1.104(c) requirement. The Applicants respectfully request the rejections be withdrawn.

CONCLUSIONS

Reconsideration and allowance of pending claims 1-52 in light of the above remarks is respectfully requested. If, after considering this reply, the Examiner believes that a telephone conference would be beneficial towards advancing this case to


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allowance, the Examiner is strongly encouraged to contact the undersigned attorney at the number listed.

Respectfully submitted,

6/20/2003
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